

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Office Action dated January 14, 2009. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 38-57 are pending in the Application.

In the Office Action, the drawings are objected to for not showing the features of claim 42. In response, FIG. 1 is amended to show the features of claim 42. Further, the specification is amended to describe the features of claim 42 in the specification. No new matter is added by this amendment as the specification previously provided for an embodiment wherein "the area of examination can be subject to sound that causes magnetostriction in at least a portion of the magnetic particles." (See, present application, page 5, lines 22-24.) A Replacement Sheet including FIGS. 1 and 2 is enclosed. Applicants respectfully request approval of the enclosed proposed drawing and specification changes and withdrawal of the drawing objection.

Claims 43 and 57 are objected to for informalities. In the interest of advancing consideration and allowance of the claims, the Applicants have elected to amend claims 43 and 57 in accordance

with the Examiner's suggestions. With the above-noted changes, it is respectfully submitted that the claims are in proper form. Accordingly, withdrawal of the objection to claims 43 and 57 is respectfully requested.

Claims 39, 45 and 47 are rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite. This rejection under 35 U.S.C. §112, second paragraph is respectfully traversed. However in the interest of advancing consideration and allowance of the claims, claim 39 is amended herein. Regarding claim 45, claim 45 recites (emphasis added) "comprising an act of correlating" and as such, there need be no prior antecedent use of the term "correlating" for claim 45 to be in proper form. Regarding claim 47, claim 47 depends from claim 46. Claim 46 provides (emphasis added) "comprising an act of selecting a magnetic particle composition having a magnetization curve with a magnetization step change." Accordingly, claim 46 provides proper antecedence to "the magnetization step change" recited in claim 47 as presented. Accordingly, it is respectfully submitted that claims 39, 45 and 47 are in proper form and it is respectfully requested that these rejections under 35 U.S.C. §112, second paragraph, be withdrawn.

In the Office Action, claims 38 and 43 are rejected under 35

U.S.C. §102(e) over U.S. Patent Publication No. 2003/0085703 to Gleich ("Gleich"). Claims 40-42, 44-46 and 49-58 are rejected under 35 U.S.C. §103(a) over Gleich in view of Applicants Admitted Prior Art ("AAPA"). These rejections are respectfully traversed. It is respectfully submitted that claims 38-57 are allowable over Gleich in view of AAPA for at least the following reasons.

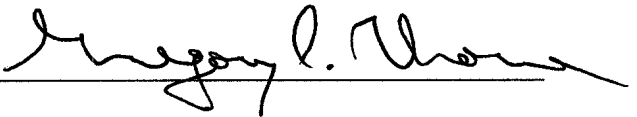
Gleich has a filing date of October 15, 2002 and a publication date of May 8, 2003 and therefore may only be considered prior art if considered under 35 U.S.C. §102(e). However, Gleich has a common inventorship to the current patent application in that the sole inventor under Gleich, namely Bernhard Gleich, is a joint inventor to the present patent application. Therefore, under 35 U.S.C. §102(e), Gleich is not nor could it be considered an application by another as required to be considered prior art under 35 U.S.C. §102(e). Accordingly, it is respectfully submitted that no declaration is required under either of 37 CFR §1.132 nor 37 CFR §1.131 to establish this position since Gleich necessarily must have been invented by one of the Applicants of the present patent application, namely the sole inventor of U.S. Patent Publication No. 2003/0085703 and a co-inventor of the present patent application.

Further, as the rejection of each of claims 38-57 includes reliance on Gleich, the Applicants respectfully submit that claims 38-57 are allowable for at least this reason as well as for the separately patentable elements contained in each of the claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response including the position regarding what is alleged to be Applicants Admitted Prior Art. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded including the position regarding what is alleged to be Applicants Admitted Prior Art.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

By 

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April 13, 2009

Enclosure: Replacement drawing sheet (1 sheet including FIGs. 1, 2)

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